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OFFICE OF PETITIONS

In re Application of :
Meyer et al. :
Application No. 09/633087 :
Filing or 371(c) Date: 08/04/2000 :
Attorney Docket Number: :
(TT3327) : ON PETITION

This is a decision on the "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," filed January 31, 2008. The petition is properly treated under 37 CFR 1.181(a).

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed June 18, 2007. The Office action set a three (3) month period for reply. No response having been received, the application became abandoned on September 19, 2007. The mailing of this Decision precedes the mailing of a Notice of Abandonment was mailed December 31, 2007.

Applicant files the present petition and states that the Office action was not received. Applicant states that it believes the Office action was not received because the Patent Office indicated the wrong correspondence address for this application. Applicants point out that a Notice of Change of Correspondence Address was filed on October 5, 2003. However, upon searching the file, Applicant notes from the correspondence received from the U.S. Patent and Trademark Office that Applicant's address had not been changed from previous counsel. Applicant believes that the correspondence may have been sent to the wrong address. Applicant files a copy of its docket records, and states that

> When an Office action requiring a response is received from the U.S. Patent Office by our office, the due date for responding to the Office action is entered into out computerized docketing system. The information is entered using the Attorney Docket Number identified

on the office action. The office action is subsequently routed to and physically placed into the corresponding application file.

Applicant's representative encloses a copy of the docket record corresponding to the above referenced application. If the allegedly mailed Office Action was received, the docket record would indicate a due date for response, the typical response to an Office Action. The enclosed docket record copy dos not show an Office Action response due date, thus indicating that the Office Action was not received from the U.S. Patent Office. Applicant's representative has searched the respective file and can find no indication of the allegedly mailed Office action therein.

Review of Office records

A review of Office records reveals that the Office action, along with two previous Office actions, mailed March 30, 2004 and October 20, 2006, respectively, were inadvertently mailed to an incorrect correspondence address. Applicants received, docketed and responded to the prior Office actions; however, Applicants assert that this Office action was not received. Applicants do not explain how it is that the prior Office actions were received, docketed and responded to, over a period of more than two years after the correspondence address had changed. Instead, with the final Office action, Applicant's allege nonreceipt.

Applicable Law, Rules and MPEP

The MPEP 711.03(c)A, Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action, provides

> In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion

> that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions). (Emphasis supplied)

MPEP 711.03(c)

Analysis

A review of Applicant's docket records reveal that Applicants received, docketed and responded to previous Office actions, mailed March 30, 2004 and October 20, 2006, respectively. Both Office actions were mailed well after the Applicants correspondence address had changed, and in the case of the latter non-final Office action, mailed October 20, 2006, it was mailed more than three years after the correspondence address change was filed. Yet this Office action was received, entered and docketed, and responded to by Applicant, including a one-month extension of time request and fee. Applicants took no issue with the mailing of the Office action to an incorrect mailing address. Applicants did not assert at that time, that the Office action was mailed to an incorrect correspondence address, possibly costing Applicant time in preparing and filing a response. Instead, Applicants paid the extension of time fee in order to render the reply, filed February 23, 2007, timely, without comment on the mailing of the Office action to an incorrect correspondence address.

Only now, with the mailing of the final Office action, does Applicant attempt to rely upon the non-entered change of correspondence address to support a re-mailing of the Office action and a resetting of the period for reply. In view of Applicant's reliance upon the docketing system as evidence that the final Office action, mailed to the previous correspondence address, was not received, and in view of evidence that the receipt of two previous Office actions, mailed March 30, 2004 and October 20, 2006, respectively, both of which were mailed to the previous correspondence address, yet received by and responded to by Applicant, there is a question of whether the final Office action may have been lost after receipt.

Conclusion

The petition is dismissed without prejudice. Applicant should file a request for reconsideration and clarify for the record the inconsistency, and explain how it is that Office actions mailed to the prior correspondence address, one of which was mailed more than three years after the correspondence had changed, were received, entered and docketed, and responded to by applicant, while the final Office action, mailed less than eight (8) months after the non-final Office action and to the same previous correspondence address of record, does not point to a conclusion that the Office action was lost after receipt, rather than lost in the mail.

Alternate venue

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions